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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TETSURO MOTOYAMA and AVERY FONG

Appeal 2008-2010
Application 09/782,064
Technology Center 2100

Decided: October 28, 2008

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-25. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

THE INVENTION

Appellants' invention relates generally to a method, system and program product for monitoring and communicating events at plural target applications of an application unit by using at least one resource such as a Dynamic Linked Library (DLL) for multiple data formats and multiple communication protocols (Spec. 4). More particularly, Appellants' invention incorporates an application unit that specifies at least one communication protocol to be used to report the information in at least one data format from the application unit (Spec. 4-5).

Independent claim 1 is illustrative:

1. An object-oriented method of collecting information regarding a plurality of target applications in an appliance or device, comprising:

receiving, from a first one of the plurality of target applications through an interface, by a monitoring device in the appliance or device, a request to send first information regarding monitored usage of the first one of the plurality of target applications to a first predetermined destination through a first communication protocol using a first data format; and

receiving, from a second one of the plurality of target applications through the interface, by the monitoring device, a request to send second information regarding monitored usage of the second one of the plurality of target applications to a second predetermined destination through a second communication protocol using a second data format, wherein the first communication protocol is different from the second communication protocol.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the obviousness rejections:

Aikens	US 5,414,494	May 9, 1995
Webb	US 5,727,135	Mar. 10, 1998
Venkatraman	US 5,956,487	Sep. 21, 1999
D'Souza	US 6,745,224 B1	Jun. 1, 2004

THE REJECTIONS

Claims 1-4, 9-12, 17-20, and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Aikens in view of Venkatraman and Webb.

Claims 5-8, 13-16, and 21-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Aikens in view of Venkatraman and Webb and D'Souza.

CONTENTIONS BY APPELLANTS

Appellants contend that the Examiner erred in rejecting the independent claims on appeal under 35 U.S.C. §103(a) because the cited combination of references fails to teach or suggest "receiving, from a first one of the plurality target applications through an interface, by a monitoring device in the application or device, a request [to send] first information regarding monitored usage of a first one of plurality of target applications to a first predetermined destination [through] a first communication protocol

using a first [data] format, as recited in [c]laim 1." (App. Br. 8). Appellants note that remaining independent claims 9 and 17 recite limitations analogous to the limitations recited in claim 1 (Spec. 11).

ISSUE

We consider the question of whether Appellants have shown that the Examiner erred in finding that the combination of Aikens and Venkatraman and Webb teaches or suggests the argued limitations of "receiving, from a first one of the plurality target applications through an interface, by a monitoring device in the application or device, a request to send first information regarding monitored usage of the first one of the plurality of target applications to a first predetermined destination through a first communication protocol using a first data format." (Claim 1; see equivalent limitations recited in independent claims 9 and 17).

PRINCIPLES OF LAW

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case

with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellants' Briefs to show error in the proffered prima facie case.

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

The Aikens reference

1. Aikens teaches "[a] method of automatic notification to selected remote devices in response to machine conditions detected by a machine monitoring element." (Abstract).
2. Aikens teaches, as illustrated in FIG. 2, in general block form, the control of the base machine 30 as shown in FIG. 1 (col. 4, ll. 27-29).
3. Aikens teaches "[t]he base machine is controlled by a plurality of printed wiring boards interconnected to a common channel or bus 98." (Col. 4, ll. 29-31, Fig. 2).
4. Aikens teaches that "one of the printed wiring boards, for example, board 102 could be the master control for the other printed wiring boards . . . ." (Col. 4, ll. 40-45, Fig. 2).
5. Aikens teaches that user interface 36 is "designed for use by the user for making the selections of the desired functions and for giving instructions regarding the conditions for the execution of the selected function, and this system is provided with a color display unit 51 and a hardware control panel 52 with control and machine feature buttons installed by the side of the said display unit, and it is further combined

with touch board 53 with other feature and control switches, so that instructions can be given directly with the "soft buttons" on the screen." (Col. 4, ll. 15-24, Fig. 2).

The Webb reference

6. Webb teaches "[t]he NPAP specification defines a bidirectional mode of communication between a host and a mutually compatible printer as a means of returning printer status information to the host." (Col. 7, ll. 46-49).

ANALYSIS

Issue

We decide the question of whether Appellants have shown that the Examiner erred in finding that the combination of Aikens, Venkatraman, and Webb teaches or suggests the argued limitations of "receiving, from a first one of the plurality target applications through an interface, by a monitoring device in the application or device, a request to send first information regarding monitored usage of the first one of the plurality of target applications to a first predetermined destination through a first communication protocol using a first data format." (Claim 1; *see* equivalent limitations recited in independent claims 9 and 17).

Appellants support their principal argument on appeal as follows:

> ***Claim 1 requires that the request comes from the target application itself*** for the monitoring device to send the monitored usage information of the target application

> that sent the request. The **'135** application [patent to Webb] does not teach or suggest the target application that sends a request for information regarding its usage to be sent to another device. Rather, the **'135** patent is directed to a system in which a host computer is able to visually and functionally duplicate the operator panel of a selected printer, thereby receiving alert and status information.

(App. Br. 9).

The Examiner responds that the limitation of "itself" is not positively recited in the claim (Ans. 23). The Examiner notes that Aikens discloses an all in one copier and printer (Figure 2), as also taught by Webb in Figure 1 (Ans. 23). The Examiner further asserts:

> As discuss[ed] in the rejection above, specifically Aiken discloses a printer device with operation monitoring (collection) capabilities (Aikens Abstract), whereby said printer comprises control boards (target applications) providing control for predetermined systems of said printer (Aikens Figure 2 items 102, 104, and 106). Since Aikens teaches that any one of the control boards can be the master control for the other boards, Aiken Figure 2 item 108 (with modem item 120), can be designated as the master controller. In order for item 36 and 52 of Aikens (Aikens internal user interface - see Aikens Figure 2) to monitor accordingly, communication (i.e. a "first request" for "first" information) commences between said **interface,** the master control, and the various control board **applications** (one or more boards) utilizing communication channel 98, said information comprising monitoring (i.e. usage) information.

(Ans. 23-24).

While we agree with the Examiner that the literal term "itself" is not recited in the independent claims on appeal, we nevertheless also agree with Appellants that the language of each independent claim clearly requires a monitoring device in the appliance or device to receive a request from a target application regarding the monitored usage of the first one of the plurality of target applications (claims 1, 9, and 17). The Examiner has read the recited "target applications" on the software components of printed wiring boards 102, 104, and 106 of Aikens (Fig. 2). While Aikens does teach that one of the printed wiring boards could be the master control for the other printed wiring boards (FF 4), the Examiner asserts in the rejection that the request to send first information regarding monitored usage of the first one of the plurality of target applications "*commences* between said interface [Aikens 36], the master control [Aikens 108], and the various control board applications (one or more boards) utilizing communication channel 98, said information comprising monitoring (i.e., usage) information." (Ans. 4, ¶1, emphasis added).

After reviewing the record before us, we agree with Appellants' responsive argument in the Reply Brief that the Examiner's Answer does not specifically identify the monitoring device in the claimed appliance or device, and we also find that discerning the Examiner's mapping of the claim elements to the references requires speculation (Reply Br. 2).

We note that Aikens teaches that user interface 36 is "designed for use by the user for making the selections of the desired functions and for giving instructions . . . , and this system is provided with a . . . hardware control panel 52 with control and machine feature buttons . . . ." (FF 5). Thus, we

agree with Appellants' responsive argument that to meet the argued limitations of each independent claim, "a request must be sent from [Aikens'] board 102 [i.e., target application] *via the user interface 36*[,] to an unidentified monitoring device in the printer." (Reply Br. 2). As further pointed out by Appellants, to meet the language of the claim the request must be a request from Aikens' board 102 (target application) to send particular information to board 108 (first predetermined destination), where the particular information regards monitored usage of the first one of the plurality of target applications (i.e., printed wiring board 102) (Reply Br. 2). We find no such teaching in Aikens. We note that the Examiner looks to the secondary Venkatraman reference for its teaching of HTTP (first communication protocol), and to the tertiary Webb reference for purportedly teaching all of the limitations of the second "receiving" clause of claim 1 (Ans. 5-6).

After considering the totality of the record before us, it is our view that the weight of the evidence supports Appellants' contention that the Examiner has not sufficiently shown the correspondence between the claim elements and the relevant portions of the cited references to establish a prima facie case of obviousness. In the mapping proffered by the Examiner, we find no specific teaching or suggestion of a monitoring device *in the appliance* receiving a request from a target application in the manner claimed, given that the Examiner has read the claimed target applications on the assumed software components of printed wiring boards 102, 104, and 106 of Aikens (Fig. 2).

For us to affirm the Examiner on this record would require speculation on our part. In particular, we find the gap in the combined teachings of the cited references to be uncomfortably wide and such gap cannot be bridged with theories or speculation. In the alternative, if the Examiner is relying upon an inherent teaching in the cited references, our reviewing court has established that "[i]nherency … may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). In particular, we find the mere "commencing" of communication (as proffered by the Examiner) is not enough to meet the specific limitations associated with the "request to send first information," as discussed above (*see* Ans. 4, ¶1). We also find that the secondary Venkatraman and tertiary Webb references do not overcome the deficiencies of the primary Aikens reference.

Therefore, for essentially the same reasons set forth by the Appellants in the Briefs, we find that the *combination* of Aikens, Venkatraman, and Webb does not fairly teach or suggest the argued limitations of "receiving, from a first one of the plurality target applications through an interface, by a monitoring device in the application or device, a request to send first information regarding monitored usage of the first one of the plurality of target applications to a first predetermined destination through a first communication protocol using a first data format," as claimed (*see* independent claim 1 and the equivalent limitations recited in independent claims 9 and 17). Accordingly, we conclude that Appellants have shown that the Examiner erred.

Therefore, we reverse the Examiner's rejection of independent claims 1, 9, 17 as being unpatentable over Aikens in view of Venkatraman and Webb. Because we have reversed the Examiner's rejection of each independent claim on appeal, we also reverse the Examiner's rejection of each dependent claim on appeal.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting claims rejecting claims 1-25 under 35 U.S.C. §103(a) for obviousness.

DECISION

We reverse the Examiner's decision rejecting claims 1-25.

REVERSED

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